

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF PUERTO RICO

BAYER AG, et al.,

Plaintiffs

v.

BIOVAIL LABORATORIES, INC.,
et al.,

Defendants.

CIVIL NO. 98-1282 (RLA)
CIVIL NO. 98-1340 (RLA)
CIVIL NO. 98-1494 (RLA)
CIVIL NO. 98-1768 (RLA)

RECEIVED & FILED
JAN 21 PM 3:57
CLERK'S OFFICE
U.S. DISTRICT COURT
SAN JUAN, P.R.

ORDER DENYING MOTION TO COMPEL

The Court having reviewed the arguments submitted by the parties as well as the transcript of the deposition of MS. DINA KHAIRO, employee of BIOVAIL CORP. INTERNATIONAL, hereby finds that the attorney-client privilege was properly raised by counsel.

The objections were limited to those particular questions which required the deponent to fully disclose the substance of communications exchanged during meetings in which defendant's counsel were present and their legal advise was being sought. The fact that the role of the attorneys during those meetings was in connection with preparation of the ANDAs and that technical information was involved does not detract from the fact that counsel were there as experts in the law and to render services in that capacity. Therefore, communications between the client and counsel within this context are not subject to discovery. See Daniel A. DeVito & Michael P. Dierks, *Exploring Anew the Attorney-Client*

CIVIL NO. 98-1282 (RLA)
CIVIL NO. 98-1340 (RLA)
CIVIL NO. 98-1494 (RLA)
CIVIL NO. 98-1768 (RLA)

Page 2

Privilege and Work-Product Doctrine in Patent Litigation: The Pendulum Swings Again, This Time in Favor of Protection, 22 AIPLA Q.J., 103 (Spring, 1994). See also Paul R. Rice, *Attorney-Client Privilege: Continuing Confusion about Attorney Communications, Drafts, Pre-Existing Documents, and the Source of the Facts Communicated*, 48 American Univ. L. Rev., 967, 1005 n.67 (1999); Grace M. Giesel, *The Legal Advice Requirement of the Attorney-Client Privilege: A Special Problem for In-House Counsel and Outside Attorneys Representing Corporations*, 48 Mercer L. Rev. 1169, 1214 (Spring 1997).

Based on the foregoing, Plaintiffs Bayer AG, Bayer Corporation and Pfizer Inc.'s Brief in Support of Motion to Compel Discovery, filed on January 7, 2000 (docket No. 66)¹ is **DENIED**.

This Order shall be notified by **FAX** and mail.

IT IS SO ORDERED.

San Juan, Puerto Rico, this 20th day of January, 2000.



RAYMOND L. ACOSTA
United States District Judge

¹ See Response, filed by defendants on January 18, 2000 (docket No. 68).